

*REMARKS/ARGUMENTS**The Pending Claim*

Claims 1-4 and 6-13 are pending and directed to a method of preparing a library of membrane proteins embedded in liposomes (claims 1-4, 5-7, 12, and 13) and a library obtained by such a method (claims 8-11).

Amendments to the Specification

The specification has been amended to include a "Cross-Reference to Related Applications" section containing the information previously submitted on the Application Data Sheet. No new matter has been added by way of this amendment.

Amendments to the Claims

The claims have been amended to point out more particularly and claim more distinctly the invention. In particular, claim 1 has been amended to recite the features of claim 5 (now canceled). Claim 8 has been amended to depend from claim 1. Claim 12 is new and is supported by the specification at, for example, page 25, lines 16-17. Claim 13 is new and recites that the library of membrane proteins is free of detergents, denaturing agent, and organic solvents, which is supported by original claim 1. Claim 1 has been amended to no longer recite this feature. No new matter has been added by way of these amendments.

Office Action

The Office Action sets forth a restriction requirement as between (1) the method of preparing a library of membrane proteins embedded in liposomes (Group I; claims 1-7) and (2) a library of membrane protein-embedded liposomes (Group II; claims 8-11). The Office Action also sets forth two election of species requirements (Subgroup I: species of compound of membrane protein; and Subgroup II: species of liposome).

Applicants' Election

Applicants elect, with traverse, the claims of Group II (claims 8-11) directed to a library of membrane protein-embedded liposomes.

With regard to the species election requirements, Applicants elect, with traverse, G protein-coupled receptors and C5a receptor for Subgroup I and yolk lecithin for Subgroup II. All of the claims (i.e., claims 1-4 and 6-13) read on the elected species.

Reconsideration of the group and species restriction requirements is hereby requested.

Discussion of the Restriction Requirement

The subject application is the U.S. national phase of International Patent Application No. PCT/JP04/10540. The Office alleges that the inventions defined by the claims of Groups I and II do not relate to a single general inventive concept under PCT Rule 13.2 because they lack the same "special technical features." Under PCT Rule 13.2, a group of inventions is considered linked to form a single general inventive concept where there is a technical relationship among the inventions that involves at least one common or corresponding special technical feature. PCT Rule 13.2 defines the term "special technical features" as meaning those technical features that define the contribution which each claimed invention, considered as a whole, makes over the prior art (see M.P.E.P. § 1893.03(d))

The claims of Groups I and II are linked so as to form a single general inventive concept. In other words, the claims of Groups I and II share a common special technical feature, which defines the contribution that each claim makes over the prior art. In this respect, all of the claims recite a library of membrane protein-embedded liposomes with a weight ratio of the membrane proteins to lipids constituting the liposomes of from 0.01 to 0.8. Such a feature is not taught or disclosed in the prior art, including Tanaka et al. (WO 02/56026).

Given the special technical feature common to the claims of Groups I and II, a search for prior art with respect to either Group I or Group II would likely uncover references that would be considered by the Examiner during the examination of the other group. Thus, Applicants respectfully submit that there would not be a serious burden on the Examiner if the groups and species of the pending claims were searched together. The nature of the claims, and the subject matter encompassed by the claims, is such that there would be no undue burden on the Examiner to consider all of the claims at the same time. Indeed, the claims of both Group I (i.e., claims 1-4, 6, 7, 12, and 13) and Group II (i.e., claims 8-11) recite

a membrane protein library, and the claims of Group II (i.e., claims 8-11) are dependent upon claim 1 of Group I. Applicants are not asserting that the pending claims necessarily stand and fall together. Instead, Applicants contend that the relationship of the pending claims, and the subject matter encompassed by the pending claims, renders the restriction requirement improper.


Similarly, in view of the nature of the subject matter defined by the pending claims, the election of species requirements are inappropriate. There should be no need to select a species of compound of membrane proteins and a species liposomes for a *library* of membrane protein-embedded liposomes and a method of preparing a *library* of membrane proteins-embedded in liposomes.

Accordingly, Applicants respectfully request that the Examiner withdraw the group and species restriction requirements issued against the pending claims. In any event, consistent with an election of species requirement, other species within the elected "genus" should be considered by the Examiner upon an indication of allowable subject matter with respect to the elected species. Moreover, if the elected product claims are found to be allowable, Applicants reserve the right to seek the rejoinder of the nonelected process claims, which is consistent with the Examiner's comments on page 8 of the Office Action.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,



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